IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Board of Patent Appeals and Interferences

(LHTLG No. 00,500)

In the Application of:	)
	)
McDonald, Patrick D.	)
	) Examiner: **Ackers, Geoffery**
Serial No. **09/698,905**	)
	)
Filing Date: **October 27, 2000**	) Group Art Unit: **3625**
	)
For: **Method and System For Processing**	)
Unclaimed Property Information	) Confirmation No. **8219**
	)

Mail Stop: **Appeal**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

(33 total pages including this transmittal letter)

1. We are transmitting herewith the attached papers for the above identified patent application:

    ☒ **PATENT APPEAL BRIEF under 37 C.F.R. 1.192 for a Notice of Appeal filed April 19, 2005 under 37 C.F.R. 191 (32 Pages).**

2. **FEES:** For a Patent Appeal Brief under 37 C.F.R. 41.20(b)(2) of $250.00 for a small entity under 37 C.F.R. 1.27(a).

3. **GENERAL AUTHORIZATION TO CHARGE OR CREDIT FEES:** No other fees or extension of times are required. Should this assumption be incorrect please charge any additional fees (or credit overpayment) to Deposit Account No. **50-2281** for **Lesavich High-Tech Law Group, PC (32097)**. If an extension of time is required and available consider this a petition and request therefor under 37 CFR § 1.136.

3. **CERTIFICATE OF MAILING under 37 CFR § 1.10**, the correspondence identified above was deposited with the United States Postal Service as "Express Mail Post Office to Addressee," addressed to the Mail Stop: Appeal, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on the 13th Day of **June 2005**. Express Mail Number **EV661802951US**.

Respectfully submitted,

Lesavich High-Tech Law Group, P.C.

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June 13, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Board of Patent Appeals and Interferences
(LHTLG No. 00,500)

In re Application of:)	
)	
Patrick D. McDonald)	
)	Art Unit: **3625**
Serial No. **09/698,905**)	
)	Examiner: **Akers, Geoffrey**
Filed: **October 27, 2000**)	
)	Confirmation No. **8219**
For: **Method and System for**)	
Processing Unclaimed Property)	
Information)	

Mail Stop: Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT APPEAL BRIEF

37 C.F.R. §1.192

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BRIEF OF APPELLANT

This is a Patent Appeal Brief submitted under 37 C.F.R. § 1.192 to the Board

of Patent Appeals and Interferences from the third rejection of all of the claims of

the application. This Appeal Brief is accompanied by the requisite fee set forth in 37

C.F.R. § 41.20(b)(2) for a small entity under 37 C.F.R. § 1.27(a). The Notice of

Appeal under 37 C.F.R. § 1.191 was filed on April 19, 2005.

REAL PARTY IN INTEREST

The Appellant, Patrick D. McDonald, is the real-party in interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences known to the Appellant.

STATUS OF CLAIMS

The status of the claims is as follows:

1. Claims at filing: 1-26
2. Claims amended on September 9, 2004, 1,3-8, 10-12, 18 and 25 based on agreements made during an Examiner Interview.
3. Claims pending: 1-26.
4. Claims rejected: 1-26.
5. Claims allowed: None.

Thus, the claims on appeal are claims 1-26.

STATUS OF AMENDMENTS

All amendments filed in the application have been entered as understood by

the Appellant.

SUMMARY OF THE INVENTION

A method and system for unclaimed property information is presented.

Unclaimed property information is periodically and automatically obtained from one

or more unclaimed property repositories. The unclaimed property information

maintained in plural different formats at the one or more unclaimed property

repositories is automatically transformed into a unified unclaimed property

information database format. Multiple database records are created in an

unclaimed property database using the unified unclaimed property information

database format. Owners of unclaimed property, identified in the unclaimed

property database are automatically located by searching one or more other

databases on public and private computer networks such as the Internet. A located

owner of unclaimed property is automatically notified as to the existence and

amount of unclaimed property with electronic mail, an automatic voice recording or

via paper documents. A graphical user interface available on a computer network is

presented that allows an identified owner of unclaimed property to request

unclaimed property. The graphical user interface is used to automatically request

that unclaimed property from the one or more unclaimed property repositories for

the identified owner be disbursed to the identified owner of unclaimed property.

(Appellant's Application - Abstract, pages 8-27).

GROUPING OF CLAIMS

Claims 1-26 stand and fall together. A current listing of Claims 1-26 is

included in Appendix A.

ISSUES PRESENTED FOR REVIEW

1.   Whether Examiner Akers violated Patent Office rules and

procedures by ignoring an agreement made by the Appellant with

Examiner Thompson during a phone interview conducted with the

Appellant.

2.   Whether claims 1-7, 10-11, 25-26 are unpatentable under 35 U.S.C.

§102(b) over Borland Paradox for Windows, User's Guide,

hereinafter, "Paradox."

3.   Whether claims 8-9, 12-24 are unpatentable under 35 U.S.C.

§103 (a) over Borland in view of Office Notice.

4.   Whether claims, 2, 13 and 30, computer readable medium claims,

are unpatentable under 35 U.S.C. §101 as being non-statutory

subject matter.

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ARGUMENT for ISSUE 1

Examiner Forest Thompson, who originally was handling the Appellant's

application rejected all of the Appellant's claims under 35 U.S.C. §102 and §103 over

Paradox. Examiner Thompson initially asserted the Appellant was simply trying to

patent a database, when in fact the Appellant was trying to patent a method and

system for automatically and periodically obtaining, processing and storing

unclaimed property information in a database and using the unclaimed property

information to automatically notify owners of unclaimed property information via

computer networks such as the Internet.

In a telephone interview with Examiner Forest Thompson on August 23,

2004, the Appellant distinguished the claimed invention over Paradox to the

satisfaction of Examiner Thompson. The Appellant explained to Examiner

Thompson that the Appellant was not trying to simply patent a database and that

claimed invention included implicit automated acquisition, processing and use of

unclaimed property information with database components (See Appellant's

Application FIG. 1 and FIG. 2 and related text).

However, Examiner Thompson requested, and the Appellant agreed, to

amend the claims to make the automated processing of unclaimed property

information explicit with the understanding that all of the Examiner's rejections

with respect to the Paradox reference would be overcome. Even though the

Appellant felt such claim amendments were unnecessary, the Appellant agreed to

amend the claims as requested by Examiner Thompson. The Appellant considered

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such amendments part of typical negotiations completed during prosecution of a

patent application to move a patent application towards allowance.

Examiner Forest Thompson indicated that if the claims were amended as

discussed during the phone interview, the claims would be clearly distinguished over

Paradox and both the Section 102 and Section 103 rejections would be immediately

withdrawn. (See Page 3 of the Interview Summary mailed August 25, 2004).

Examiner Thompson also indicated that he would conduct a new search based his

new understanding of the invention based on the amended claims to ensure that no

other prior art references included automated acquisition and processing of

unclaimed property information. The Appellant, in good faith and relying on the

word of Examiner Thompson filed an amendment and response on September 9,

2004 along with a Request for Continuing Examination (RCE). It is the Appellant's

understanding that Examiner Thompson has left or retired from the Patent Office.

In the Office Action Mailed October 22, 2004, the Appellant was very

surprised and disappointed to see that Examiner's Akers, a new examiner assigned

to the application, ignored Examiner Thompson's written agreement with the

Appellant and simply maintained the Section 102 and Section 103 rejections over

the Borland Paradox reference and added a Section 101 rejection that doesn't make

much sense based on current patent rules and controlling case law. Examiner Akers

also did not conduct a new search as was also indicated in the interview summary by

Examiner Thompson. The Appellant tried to reach Examiner Akers but Examiner

Akers has returned none of the Appellant phone calls. The Appellant tried to reach

the Examiner's Supervisor, but she returned none of the Appellant's phone calls.

Examiner Akers asserted in the last Office Action reinstating the original

rejections that "automating a known process is not a basis for novelty." However, as

was just discussed above, the Appellant's claimed invention was implicitly automatic

anyway (See FIG. 1 and FIG. 2 and accompanying text) and the Appellant simply

amended the claims to include an explicit indication of this automation. In fact,

after making that assertion, Examiner Akers goes on to admit that "obtaining

information and data electronically encompasses the feature of automatically

performing the operation." Thus, even Examiner Akers appeared to understand the

Appellant's invention was implicitly automatic before the claim amendments based

on his statements. This admission about automation also distinguishes the

Appellant's invention over Paradox, a manual database tool in the Examiner's own

words.

The Appellant submits that Examiner Akers violated patent office rules,

especially MPEP §713.01 which clearly states *"Sometimes the examiner who*

conducted the interview is transferred to another Technology Center or

resigns, and the examination is continued by another examiner. If there is

an indication that an interview had been held, the second examiner should

ascertain if any agreements were reached at the interview. Where conditions

permit, as in the absence of a clear error or knowledge of other prior art, the

second examiner should take a position consistent with the agreements

previously reached."

An agreement clearly had been reached between the Appellant and Examiner Thompson. There was an interview summary in the prosecution history, although Examiner Ackers made no indication he reviewed the interview summary. If Examiner Ackers read the interview summary, based on Examiner Akers comments in the Office Action, there was also no indication of clear error on the part of Examiner Thompson, an experienced patent examiner who spent a long career at the patent office before leaving or retiring. Examiner Ackers also did not provide any knowledge of other prior art, or any other prior art at all. In addition, Examiner Akers did not conduct another search as Examiner Thompson indicated in writing to the Appellant would be done. Examiner Ackers simply sent out another office action repeating the previous rejections and adding a new Section 101 rejection with virtually no additional commentary.

Examiner Ackers also appears to be unfamiliar with the correct application of patent rules and the current case law with respect to patentable subject matter for computer related inventions as is explained below.

The Appellant had a written agreement Examiner Thompson. Examiner Ackers breached that agreement. The Appellant would <u>not</u> have amended the claims at all and would have appealed the original claims to the Appeals Board if an agreement could not have been reached with Examiner Thompson.

Breaching such written agreements made with examiners is a violation of the patent rules, detrimental to the patent process and is unequitable to the Appellant. Applicants for patent applications have to be able to trust and rely upon agreements reach with the Patent Office. Otherwise, there is no reason to allow examiners to conduct interview with patent applicants or an applicant to amend any claims at all without taking every rejection immediately to appeal.

CONCLUSION FOR ISSUE 1

Based on these remarks, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw all rejections and immediately pass all the claims to allowance.

ARGUMENT FOR ISSUE 2

(1) A claim is anticipated under 35 U.S.C. §102 if and only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

(2) To make a *prima case* of anticipation under 35 U.S.C. §102, the identical invention must shown in as complete detail in a single prior art reference as is contained in the allegedly anticipated claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

I. EACH AND EVERY CLAIM ELEMENT OF THE CLAIMS ARE NOT FOUND IN PARADOX.

Claim 1 is used to argue the Appellant's position. The same arguments apply to the Appellant's other claims 2-26. Claim 1 of the Application recites automatically obtaining periodically a plurality of unclaimed property information from a plurality of unclaimed property repositories, wherein the plurality of unclaimed property information is maintained in a plurality of different formats by the plurality of unclaimed property repositories; automatically transforming the plurality of unclaimed property information maintained in the plurality of different formats into a unified database format, thereby creating transformed unclaimed property information; and automatically creating a plurality of database records in an unclaimed property database with the transformed unclaimed property information using the unified database format.

The Appellant has traversed all of the Examiners' assertions in all of the previous office actions and clearly explained the Appellant's invention to the Examiners. The Examiners provided only a *small portion* of the Paradox manual (specifically pages i-xi, and pages 31-32, 107-110,151-153,253-258,269-275,308-312, 409-411) that was used to assert the Examiner's position. The Appellant submits to the Appeals Board that using the Examiners' logic to reject the Appellant's invention over Paradox just because the Appellant's invention includes claim elements with database components, then any invention that included any database componets should also have been rejected over Paradox. Clearly this is not what the Patent

Office did (or could have done under the patent rules) as there are huge numbers of

issued patents that include database components that were not rejected over

Paradox. The Appellant submits following arguments once again for review by the

Appeals Board.

a. Paradox does not *expressly or inherently* describe the specific claim

limitation of Claim 1 of <u>unclaimed property information</u>. In fact nowhere in the

Paradox reference supplied by the Examiner is the claim limitation <u>unclaimed</u>

<u>property information,</u> or any manipulation thereof, described or <u>even mentioned</u>.

Paradox is a general purpose database tool that requires a user execute many

manual steps to a select few types of input data that are stored in different internal

formats. Paradox does not anywhere expressly or inherently mention any steps of

automatically and periodically acquiring, manipulating <u>unclaimed property</u>

<u>information</u>, or automatically locating owner's of unclaimed property information. If

Paradox can accomplish the Appellant's invention, the reference itself does not

expressly or inherently describe it. Thus, Paradox cannot anticipate Claim 1 under

the holding of *Verdegall Bros.*

b. Paradox does not *expressly or inherently* teach the claim limitation

including <u>automatically obtaining periodically a plurality of unclaimed property</u>

<u>information from a plurality of unclaimed property repositories, wherein the</u>

<u>plurality of unclaimed property information is maintained in a plurality of different</u>

<u>formats by the plurality of unclaimed property repositories.</u>

In addition, Paradox describes many database features that are very

different from the Appellant's invention (i.e., teach away from the Appellant's

invention) including several features the Appellant's invention was in part created

to overcome. For example, In Chapter 10, of Paradox, entitled "Exchanging Data,"

Paradox teaches only three specific types of data can be manually input: (1)

spreadsheets; (2) delimited text files; and (3) fixed length text files (Page 269).

First, to import spread sheet data, a user is required to manually open a

spreadsheet import dialog box, manually enter a spreadsheet name, manually enter

a table the spreadsheet data will be imported to, manually type a range of data in a

spreadsheet block to import. (See Figure 10.9 on Page 269). Even then, Paradox

only allows specific blocks of data stored in a spreadsheet to be imported. Paradox

specifically states "you can select only a specific block in the spreadsheet to import"

(See Page 270, next to light-bulb graphic).

Second, Paradox allows data to be manually input from a delimited text file.

In a delimited text file, Paradox expects fields to be ASCII format to be separated by

commas, with quotation marks, surrounding each field. A user is required to

manually enter a file name and manually choose <Delimited Text> from the File

Type drop-down list. (See page 271 and Figure 10.11).

Finally, Paradox allows data to be manually imported from a fixed-length

text file. For fixed length text files, Paradox requires text fields of defined lengths.

A user is required to manually enter a file name, then manually choose <Fixed

Length Text> from the File Type drop-down list. For each named field, a user must

enter a Start position (the column where the user wants the field value to begin) and a Length of the field (the field size) (See Page 272).

Thus, Paradox does not describe expressly or inherently any automatic or periodic collection of plural different types unclaimed property information from plural different unclaimed property repositories. In addition, Paradox only accepts data manually imported in a few selected formats (spreadsheets, delimited text and fixed-length text) all of which require several manual steps by a user to properly import the data and the different types of data are stored in different internal formats (Table 10.3 and Figure 10.9 for spreadsheets, Figures 10.10 and 10.11 for delimited text, Figure 10.12 for fixed-length text) not a unified database formats. Therefore, Paradox cannot anticipate this claim element of Claim 1 under the holding of *Verdegall Bros.*

c. Paradox does not *expressly or inherently* teach the claim limitation including <u>automatically transforming the plurality of unclaimed property information maintained in the plurality of different formats into a unified database format, thereby creating transformed unclaimed property information; and automatically creating a plurality of database records in an unclaimed property database with the transformed unclaimed property information using the unified database format.</u>

Paradox instead teaches different types of input data are stored in several different types of internal formats. Paradox describes that when a block of a spreadsheet is imported, specific default conversion rules are followed (whether they

fit the user's requirements or not). Paradox suggests that a user manually <u>edit</u> <u>spreadsheet data before importing it to eliminate any</u> ambiguities that might occur based on the default conversion rules.

Paradox clearly states the user is required to manually edit (i.e., manually pre-process) the spreadsheet block: (1) to remove extraneous entries (such as hyphens, asterisks and exclamation points); (2) to make sure each column contains only one kind of data and uses only one formatting option; and (3) place column titles in the top row of the selected range, because Paradox use the first row that contains text to generate field names (See Page 270). Spreadsheet data is transformed into Paradox alpha, short, numeric, money and dates internal field types, a first internal Paradox format.

In direct contrast, the Appellant's invention was created in part to automatically acquire and manipulate unclaimed property information in many different formats without manual editing and automatically convert it and store it in a unified database format without placing such burdens on a user.

In addition, the automatic transforming step of Claim 1 is further clarified in dependent Claim 6, for example, by teaching the transforming step further includes automatically <u>deleting duplicate or incomplete entries</u> from the plurality of unclaimed property information. This claim limitation also teaches away from the "normal" operation of Paradox which requires a user manually locate, then remove extraneous entries on their own.

For delimited text, Paradox expects fields in ASCII format to be separated by commas, with quotation marks, surrounding each field (See Page 271). Delimited text data is transformed into Paradox data fields based on the fields used in the delimited text file (See Page 271). A second type of internal Paradox format, different than that for spreadsheets.

For fixed-length text, Paradox creates database files (e.g., IMPORT.DB file) on the user computer for which a user must manually define the structure of a new internal table. The user then manually enters field names and types of fields for a new Paradox table. For each field name, a Start position and length are manually entered. (See Pages 272 and 273). This is a third type of internal Paradox format, different than that for spreadsheets or for delimited text files.

Paradox describes three different types of non-uniform formats used internally, all different, one for a block of a spreadsheet, one for a delimited text file and one for fixed-length text file. Thus, Paradox does not describe the claim limitation <u>of automatically storing plural different types of unclaimed property information in a unified database format</u>.

Therefore, Paradox does not describe <u>each and every element</u> as set forth in this element of Claim 1 <u>either expressly or inherently</u> and the 102(b) rejection is clearly improper under the holding of *Verdegall Bros.* Therefore, the Section 102(b) rejection should be immediately withdrawn.

II. THE IDENTICAL INVENTION IS NOT SHOWN BY PARADOX.

Paradox clearly <u>does not show the identical invention</u> in as complete detail as

is contained in an allegedly anticipated Claim 1. As was described in section I

above, Paradox is a general purpose database that requires many manual user input

steps and stores different types of input data in different internal formats. The

portion of the Paradox reference as supplied by the Patent Office does not make any

mention whatsoever to automatically obtaining and processing unclaimed property

information from plural different sources in plural different formats and

automatically converting the unclaimed property information into a unified

database format.

Paradox teaches the contrary as was discussed above. Several manual steps

are required for different types of input data, each of which is stored in a different

internal format not a uniform internal format. In addition, Paradox was developed

and sold as a general database tool and not a tool to perform a method for

automatically acquiring and processing unclaimed property information.

Even if Paradox could be programmed to perform the Appellant's invention, the

reference itself does not expressly describe how to do it. None of the Examiners

have provided any plausible explanation of how Paradox can inherently be

programmed to perform the Appellant's invention (which it can not based on the

portion of the Paradox reference supplied by the Examiner). Thus, the Section

102(b) rejection is also clearly improper under the holding of *Richardson* as well.

CONCLUSION FOR ISSUE 2

Based on these remarks, Paradox does not describe every element as set forth in the claimed invention either expressly or inherently and does not show the identical invention as the claimed invention. Thus, this single reference, Paradox cannot anticipate the claimed invention. Therefore, the Examiner has not established a *prima facie* case of anticipation under §102(b). The Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw the §102(b) rejections with respect to Claims 1-7, 10-11 and 25-26 based on the holdings of both *Verdegall Bros. and Richardson.* Since these claims are not anticipated they should be immediately allowable in their present form.

ARGUMENT for ISSUE 3

(1)   To establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974); and all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

I. NOT ALL OF THE CLAIM LIMITATIONS ARE TAUGHT, SUGGESTED OR EVEN MENTIONED BY PARADOX IN VIEW OF OFFICIAL NOTICE.

With respect to Claims 8-9 and 12-18 the Examiner _admitted_ "Paradox does not specifically disclose create a plurality of pass through database records; reading the database information to determine contact information relative to the database information; or using the contact information to provide automatic notifications; electronically collecting appropriate information required by one or more service providers (e.g., unclaimed property repositories) to disburse unclaimed property; nor electronically collecting a fee" (See Page 4, First Office Action, mailed September 5, 2003).

With respect to Claims 21-24, The Examiner also _admitted_ "Paradox does not specifically disclose the fee is electronically collected automatically for a credit card, or electronically deducted from a checking or savings account. (See Pages 6-7, First Office Action, mailed September 5, 2003).

After making these admissions, the Examiner took Official Notice of the admissions, that these claim elements were old and well known at the time the Appellant filed the patent application, which the Appellant traversed.

First, all of the arguments for Paradox not describing all of the elements to anticipate Claim 1 for unclaimed property information as was discussed above, are incorporated by reference and apply here as well for the obviousness rejection.

Second, Paradox does not teach, suggest or even mention the specific claim limitation <u>unclaimed property information</u>. In fact, there isn't a <u>single issued U.S.</u>

<u>Patent</u> as searched at the USPTO website at *uspto.gov* that the Appellant can find

<u>that even mentions the claim limitation "unclaimed property information," or</u>

<u>automatic acquiring and processing of unclaimed property information, period</u>.

Third, as was discussed above, Paradox does not describe, teach or suggest all

of the claim associated with unclaimed property information as described for

independent Claim 1. Combining Paradox with the Official Notice assertions does

not change this fact. The Examiner clearly did not consider <u>all of the words</u> of the

claims. Therefore, these claims cannot be obvious under the holdings of *In re Royka*

and *In re Wilson*.

Third, Paradox does not teach or suggest, or even mention, with Official

Notice, the specific claim limitations related to automatically acquiring and

processing unclaimed property information as well as automatically locating owner's

of unclaimed property information, or accepting electronic payment from owner's of

located unclaimed property information.

CONCLUSION FOR ISSUE 3

Thus, the obviousness rejection is improper under the holdings of *In re Royka*

and *In re Wilson*. Therefore, the Examiner has <u>not</u> established a *prima facie* case of

anticipation under §103(a). Therefore, the Appellant now requests the Appeal Board

instruct the Examiner to immediately withdraw the §103(a) rejections with respect

to Claims 8-9, 12-24. Since these claims are not anticipated they should be

immediately allowable in their present form.

ARUGUMENT FOR ISSUE 4

(1)   Computer readable mediums have been statutory subject matter

under 35 U.S.C. 101 at least since the decision of *In re Lowry*, 32

F.3d 1579 (Fed. Cir. 1994).

Claims 2, 13 and 30 are dependent claims that include computer readable

mediums including method steps of their corresponding independent method claims.

Examiner Ackers apparently didn't read or understand the MPEP when applying

this rejection. The MPEP at §2106 clearly states when functional descriptive

material is recorded on some computer-readable medium it becomes structurally and

functionally interrelated to the medium and will be *statutory* since use of technology

permits the function of the descriptive material to be realized. *In re Lowry*, 32 F.3d

1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

In a search done by the Appellant on the USPTO web-site at *www.uspto.gov*,

on June 12, 2005, there were almost 16,000 issued U.S. Patent that included issued

claims including "computer readable mediums." Clearly the Patent Office has found

such claims statutory a very large number of times and should in this instance as

well. Appellant includes the search results herein.

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USPTO FULL TEXT AND IMAGE DATABASE

"Searching 1976 to present...

Results of Search in 1976 to present db for:

ACLM/"computer readable medium": 15960 patents."

Examiner Ackers also ignored the following from the holding of *In re Lowry*

clearly stated in the MPEP: (1) if a claim defines a useful machine or article of

manufacture by identifying the physical structure of the machine or manufacture

(i.e., a computer readable medium) in terms of its hardware or hardware and

software combination, it defines a *statutory* product. *In re Lowry*, 32 F.3d at 1583, 32

USPQ2d at 1034-35; (2) if a claim defines a useful machine or manufacture by

identifying the physical structure of the machine or manufacture in terms of its

hardware or hardware and software combination it defines a *statutory* product. In

re *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35.

Examiner Ackers should also be reminded that the MPEP states *"office*

personnel have the burden to establish a prima facie case that the claimed invention

as a whole is directed to solely an abstract idea or to manipulation of abstract ideas

or does not produce a useful result. Only when the claim is devoid of any limitation to

a practical application in the technological arts should it be rejected under 35 U.S.C.

101." See MPEP §2106.

Clearly Examiner Ackers has not met this burden since he provided no

explanation whatsoever as to why the claimed invention that includes method steps

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for automatically acquiring and processing unclaimed property information is devoid of any limitation to a practical application in the technical arts.

The Appellant invention certainly has practical application to the technical arts since the Appellant has a successful company for many years that in part uses the claimed invention to automatically acquire and process unclaimed property information for many government and financial organizations throughout the United States.

The Examiner's only comment about the Section 101 rejection was one sentence rejecting dependent claims 2, 13 and 20, which include the corresponding method steps of the independent claims on a computer readable medium, under Section 101 as "failing to provide a concrete, useful and tangible output."

Examiner Ackers also appears <u>not</u> to understand the holding of *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998) or *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). The Appellant's invention is a computer-related invention clearly providing a "useful, concrete and tangible result," namely automatically and periodically obtaining and processing unclaimed property information from plural different sources and storing it in a unified database format that allows additional automatic processing (e.g., automatically contacting owner's of unclaimed property, etc.) where these method steps are stored on a computer readable medium. The Appellant's invention is

stored on computer readable medium is clearly statutory under the holding of

Lowrey, State Street Bank, AT&T and all the other previous cases dealing with

computer related inventions as machines programmed for a specific function as well.

CONCLUSION FOR ISSUE 4

Thus, the Section 101 rejection is clearly improper under the patent rules and

the holdings of at least, *In re Lowry*, *State Street Bank and AT&T*. Therefore, the

Appellant now requests the Appeal Board instruct the Examiner to immediately

withdraw the §101 rejections with respect to Claims 2, 13 and 30. Since these

claims comprise statutory subject matter they should be immediately allowable in

their present form.

REQUEST FOR AN ORAL HEARING

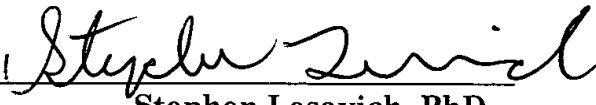Appellant hereby requests an oral hearing on this Appeal.

CONCLUSION

For the foregoing reasons, Appellant submits that the Examiner's rejection of

claims 1-26 is erroneous. Accordingly, Appellant respectfully requests that the

Appeal Board reverse the Examiner's rejection of claims 1-26 and immediately pass

all claims 1-26 to allowance.

Respectively submitted:

Lesavich High-Tech Law Group, P.C.

Date: June 13, 2005   By: _____
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                                  Registration No. 43,749

APPENDIX A
Claims 1-26

1. (Previously Presented) A method for acquiring unclaimed property information, comprising:

automatically obtaining periodically a plurality of unclaimed property information from a plurality of unclaimed property repositories, wherein the plurality of unclaimed property information is maintained in a plurality of different formats by the plurality of unclaimed property repositories;

automatically transforming the plurality of unclaimed property information maintained in the plurality of different formats into a unified database format, thereby creating transformed unclaimed property information; and

automatically creating a plurality of database records in an unclaimed property database with the transformed unclaimed property information using the unified database format.

2. (Original) A computer readable medium having stored therein instructions for causing a processor to execute the method of Claim 1.

3. (Previously Presented) The method of Claim 1 wherein the step of automatically obtaining periodically a plurality of unclaimed property information from a plurality of unclaimed property repositories includes obtaining unclaimed property information from state government agencies, federal government agencies, state court agencies, federal court agencies, public financial institutions or private financial institutions.

4. (Previously Presented) The method of Claim 1 wherein the step of automatically transforming the plurality of unclaimed property information maintained in the plurality of formats into a unified database format includes automatically processing unclaimed property information from paper documents, microfiche, CD-ROMs, or computer tapes.

5. (Previously Presented) The method of Claim 1 wherein the step of automatically transforming the plurality of unclaimed property information maintained in the plurality of different formats into a unified database format includes extracting selected information from the plurality of different formats and storing the selected information in a designated information field in the unified database format.

6. (Previously Presented) The method of Claim 1 wherein the step of automatically transforming the plurality of unclaimed property information in the plurality of different formats into a unified database format includes deleting duplicate or incomplete entries from the plurality of unclaimed property information.

7. (Previously Presented) The method of Claim 1 wherein the step of automatically transforming the plurality of unclaimed property information in the plurality of different formats into a unified database format includes combining two or more information fields from the plurality of unclaimed property information into one information field in the unified database format.

8. (Previously Presented) The method of Claim 1 wherein the step of automatically creating a plurality of database records using the unified database format in an unclaimed property database with transformed unclaimed property information includes automatically creating a plurality of pass-through database records.

9. (Original) The method of Claim 1 wherein the unclaimed property database is a pass-through database.

10. (Previously Presented) The method of Claim 1 wherein the step of automatically creating a plurality of database records using the unified database format includes automatically electronically linking selected ones of the plurality of database records in the unclaimed property database to original unclaimed property information from the plurality of unclaimed property repositories.

11. (Previously Presented) The method of Claim 1 wherein the step of automatically creating a plurality of database records using the unified database format includes:

automatically creating a database record; and

automatically linking the database record with other database records that include similar names.

12. (Previously Presented) A method of locating owners of unclaimed property, comprising:

(a)   reading a database record from an unclaimed property database, wherein the unclaimed property database includes a plurality of database

records automatically created from a plurality of unclaimed property information

from a plurality of unclaimed property repositories, and wherein the unclaimed

property information is stored in a unified database format in the unclaimed

property database;

(b)   determining whether an owner of unclaimed property

identified in the database record can be automatically located by searching one or

more other databases on public and private computer networks; and if so,

(c)   notifying automatically an owner of unclaimed property as to

the existence and amount of unclaimed property; a nd

(d)   repeating steps (a) and (b) for unique records in the unclaimed

property database.

13. (Original) A computer readable medium having stored therein

instructions for causing a processor to execute the method of Claim 12.

14. (Original) The method of Claim 12 wherein step (c) includes

notifying an owner of unclaimed property with electronic mail, an automatically

generated voice message or paper documents.

15. (Original) The method of Claim 12 wherein step (c) includes

notifying an owner of unclaimed property via a web-site, television, radio or via a

publication in a newspaper or magazine.

16. (Original) The method of Claim 12 wherein the step (c) includes

notifying an owner of unclaimed property with a unique unclaimed property

identifier that can be used by the owner of unclaimed property to electronically

request the unclaimed property electronically via a computer network.

17.   (Original) The method of Claim 11 wherein the database record

from the unclaimed property database is linked to a plurality of other database

records if an unclaimed property owner has multiple types or amounts of unclaimed

property.

18. (Previously Presented) The method of Claim 12 wherein step (a)

includes automatically searching other database records with similar information

linked to the database record.

19. (Original) A method for automatically requesting disbursement of

unclaimed property, comprising:

providing a graphical user interface available on a computer

network that allows an identified owner of unclaimed property to request unclaimed

property;

electronically collecting appropriate information required by

one or more unclaimed property repositories to disburse unclaimed property and a

fee via the graphical user interface from an identified owner of unclaimed property;

electronically processing necessary forms for the one or more

unclaimed property repositories for the identified owner of unclaimed property using

the collected information;

requesting automatically with the electronically processed

forms that unclaimed property from the one or more unclaimed property repositories

for the identified owner be disbursed to the identified owner of unclaimed property.

20. (Original) A computer readable medium having stored therein

instructions for causing a processor to execute the method of Claim 19.

21. (Original) The method of Claim 19 wherein the step of

electronically collecting appropriate information for one or more unclaimed property

repositories and a fee via a computer network from an identified owner of unclaimed

property includes only specific information required by the one or more unclaimed

property repositories to recover unclaimed property.

22. (Previously Presented) The method of Claim 19 wherein the step

of electronically collecting appropriate information for one or more unclaimed

property repositories and a fee via a computer network from an identified owner of

unclaimed property includes collecting appropriate information for one or more

unclaimed property repositories via an input form written in the Hyper Text

Markup Language or eXtensible Markup Language or the type of input form and

presented to an owner of unclaimed property via the Internet.

23. (Original) The method of Claim 19 wherein the fee is electronically

collected automatically for a credit card, debit card, or electronically deducted from a

checking or savings account.

24. (Original) The method of Claim 19 wherein the step of electronically collecting appropriate information includes automatically collecting and displaying input forms to collect appropriate information based on an unclaimed property identifier supplied to an owner of unclaimed property when the owner of unclaimed property was notified to existence of unclaimed property.

25. (Previously Presented) An unclaimed property network system, comprising in combination:

an unclaimed property acquisition module for automatically obtaining periodically a plurality of unclaimed property information from a plurality of unclaimed property repositories, wherein the plurality of unclaimed property information is maintained in a plurality of different formats by the plurality of unclaimed property repositories, automatically transforming the plurality of unclaimed property information maintained in the plurality of formats into a unified database format, thereby creating transformed unclaimed property information, and automatically creating a plurality of database records in an unclaimed property database with transformed unclaimed property information using the unified database format;

an unclaimed property identification module for reading a database record from an unclaimed property database, determining whether an owner of unclaimed property identified in the database record can be automatically located by searching one or more other databases on public and private computer networks, and if so, notifying automatically an owner of unclaimed property as to the existence and amount of unclaimed property;

an unclaimed property disbursement module for electronically collecting

appropriate information required by one or more unclaimed property repositories to

disburse unclaimed property and a fee via a graphical user interface from an identified

owner of unclaimed property, electronically processing necessary forms for the one or more

unclaimed property repositories for the identified owner of unclaimed property using the

collected information, and requesting automatically with the electronically processed forms

that unclaimed property from the one or more unclaimed property repositories for the

identified owner be disbursed to the identified owner of unclaimed property;

an unclaimed property database module for automatically storing a plurality

of unclaimed property information in an unclaimed property database in a unified database

format; and

a graphical user interface available on a computer network that allows an

identified owner of unclaimed property to request unclaimed property via the unclaimed

property disbursement module.

26. (Original) The system of Claim 25 further comprising:

an unclaimed property database including a plurality of database records

stored in a unified database format created from a plurality of unclaimed property

information from a plurality of unclaimed property repositories.